

Response under 37 CFR 1.116
Expedited Procedure
Examining Group 1751

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Behler et al.
Appl. No. : 09/463,675
Filed : 05/12/00
Title : LOW VISCOSITY DISPERSION FOR PAPER OR TEXTILE
PROCESSING

Grp./A.U. : 1751
Examiner : J. Hardee

Docket No. : H 3033 PCT/US

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the Assistant
Commissioner for Patents on the date shown below.

September 21, 2001
Date

Mariene Capren
Signature of certifier

Mariene Capren
Typed or printed name of certifier

PETITION FROM REQUIREMENT FOR RESTRICTION UNDER 37 CFR 1.144

Assistant Commissioner for Patents
Box AF
Washington, DC 20231

Sir:

Applicant hereby petitions the Honorable Commissioner of Patents and Trademarks
to review the Examiner's restriction requirement in the above-identified application for
patent.

Applicant had received an Examiner's Restriction Requirement on November 13,
2000 in the instant application.

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The Examiner stated that the present application contained the following inventions or groups of inventions which were not so linked as to form a single general inventive concept under PCT Rule 13.1.

Group A, claims 16-30 drawn to compositions and methods for using compositions containing a fatty acid as the nonionic softener; Group B, claims 16-30, drawn to compositions and methods for using compositions containing a fatty alcohol as the nonionic softener; and Group C, claims 16-30, drawn to compositions and methods for using compositions containing a nonionic softener other than a fatty alcohol or a fatty acid.

Moreover, the Examiner went on to state that after having chosen one of groups A-C, Applicant was further required to elect one of the following inventions:

Group I, claims 16-22, drawn to compositions for softening paper and textile substrates; Group II, claims 23-30, drawn to processes for softening paper substrates, and Group III, claims 23-30, drawn to processes for softening textile substrates.

The Examiner stated, at page 3 of Paper No. 7, "The inventions listed as Groups AI-CIII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The common structural feature which unites the invention does not make a contribution over the prior art in view of the reference marked X in the PCT search report."

In response to the Examiner's restriction requirement, Applicant initially noted that the claims presently pending in the application are claims 15-30, as is evidenced by Applicant's Preliminary Amendment filed January 28, 2000. Consequently, it was impossible for Applicant to elect a specific group of the invention since all of the claims have not been addressed by the Examiner.

Applicant had also argued that the premise, or lack thereof, upon which the Examiner's conclusion of lack of unity of invention was based, was completely unclear to Applicant. More particularly, under MPEP 1893.03(d) an Examiner, when making a lack

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of unity of invention requirement, **must** (1) list the different groups of claims, and (2) explain why each group lacks unity with each other group **specifically** describing the unique special technical feature in each group. Applicant's position was that while the Examiner had apparently satisfied the first requirement, the second requirement was clearly left unsatisfied. In an apparent attempt to satisfy the second requirement, the Examiner stated, "...The common structural feature which unites the invention does not make a contribution over the prior art in view of the reference marked X in the PCT search report." **Clearly** this statement woefully fails to satisfy the second requirement cited above. Moreover, the relevance of this statement with respect to a unity of invention analysis and determination remained unclear to Applicant.

The special technical feature in each Group identified by the Examiner was the nonionic softener component selected from mono- or diesters of glycerol with C₆₋₂₂ fatty acids. For some reason unknown to Applicant, the Examiner referred to the nonionic emulsifier (component (d)) as the nonionic softener which is actually component (a). Nevertheless, it was Applicant's position that since **each and every** group identified by the Examiner possessed the same special technical feature, i.e., the nonionic softener of component (a), unity of invention as between these groups clearly existed.

In response to these arguments, the Examiner maintained his election/restriction requirement on the grounds that the special technical feature identified by Applicant as being present in each of the groups identified by the Examiner failed to make a contribution over the prior art due to the citation of X and Y references in the PCT Search Report.

Applicant requested that the Examiner cite the relevant legal precedent in support of this position since Applicant was and continues to be unaware of any rule, regulation or case law which provides that the citation of X and Y references in a PCT Search Report **automatically** destroys unity of invention on the grounds that it renders the special technical feature common to all of the groups of claim incapable of making a contribution over the prior art.

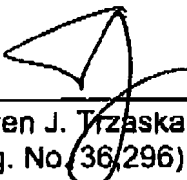
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The Examiner went on to state at page 3, paragraph 4, of Paper No. 11 that the present application contains claims 23-30 drawn to an **invention non-elected with traverse** in Paper No. 10 and that a complete response to the final rejection must include cancellation of non-elected or other appropriate action. The meaning and/or purpose of this paragraph, and specifically the highlighted portion, was and remains unclear to Applicant, particularly in view of the Examiner's statement in Paper No. 11, page 2, paragraph 1 that this restriction is NOT being made final.

In view of the above, Applicant respectfully requests that the Commissioner withdraw the Examiner's restriction requirement on the grounds that the Examiner has failed to meet the burden of proof necessary for establishing that the claimed invention lacks unity of invention.

Respectfully submitted,

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